

REMARKS

Claims 1, 4, 5, 8, 14, 19, 21, and 22 have been amended by this paper. Claims 11-13, 17, and 18 were nonelected and therefore have been canceled. Further, Claims 6, 7, and 9-10 have also been canceled. Claims 2-5, 8, 15-16 and 20 remain unchanged by this Amendment. Additionally, Claims 23-40 has been added. Hence, by this paper, Claims 1-5, 8, 14-16, and 19-34 are presented for further examination.

I. Discussion of Rejection of Claims 1-5, 8, 14-16, and 19-22 Under 35 U.S.C. § 102(e)

In paragraph 4 of the Office Action, Claims 1-5, 8, 14-16, and 19-22 were rejected as being anticipated by U.S. Patent No. 6,061,695 to Slivka, et al (hereinafter "*Slivka*") under 35 U.S.C. § 102(e). For the reasons set forth below, Applicant respectfully disagrees with the Examiner's findings and determination that Claims 1-10, 14-16, and 19-22, as amended, are anticipated by *Slivka*.

A. Brief Description of *Slivka*

Slivka describes an operating system shell which provides a graphical user interface having a windowing environment with a desktop. The shell synthesizes a hypertext page for display as the desktop in the graphical user interface. The hypertext pages are synthesized using a preprocessor from templates which can be edited to incorporate a variety of multi-media enhancements with the user interface elements in the graphical user interface.

B. The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

C. *Slivka* Fails To Anticipate the Claimed Invention

One embodiment of the claimed invention is directed to performing maintenance and diagnostic actions. In particular, independent Claim 1, as amended, recites "generating a disk

image responsive to receiving the activated hypertext link.” Independent Claim 14, as amended, recites “a computer resource configured to generate a disk image responsive to receiving the activated hypertext link.” Independent Claim 19 recites “perform a computer maintenance action with respect to the electronic device responsive to receiving the activated hyperlink request wherein the action comprises generating a disk image.” As discussed below, Applicant submits that *Slivka* does not teach or suggest, at least, this limitation of amended Claims 1, 14, and 19.

The Examiner took the position that *Slivka* teaches certain features of generating a disk image. See *Office Action* para. 4. The Examiner indicated that this is disclosed in *Slivka* by “Icons in window 180 of fig. 7.” Applicant submits that these icons merely present information regarding files stored on the computer and thus is unrelated to “generation of a disk image” as recited by Claim 1, as amended. As would be apparent to one of skill in the art, generating a disk image generally refers to making a disk clone, or copy of a computer’s hard drive. See e.g., http://www.webopedia.com/TERM/d/disk_image.html, last visited February 2, 2004. It does not refer to simply displaying an icon representing a disk as is disclosed by *Slivka*. In view of the above, Applicant submits that amended Claims 1, 14, and 19 are allowable. Furthermore, Applicant respectfully submits that Claims 2-5, 8, 13-16, and 20-21, which each depend from one of independent Claims 1, 14, or 19, also define subject matter which is patentable over the art of record for at least the reasons set forth above.

With respect to independent Claim 22, the Examiner argued that Claim 22 “is similar in scope to Claim 1 above except performing a computer maintenance action (col. 5 lines 41-57).” However, Applicant submits that nowhere does *Slivka* disclose “performing a computer maintenance action” as recited by Claim 22. The section cited by the Examiner merely discusses the meaning, in the *Slivka* disclosure, of an operation being “computer executed.” This is not related to “a computer maintenance action,” such as, for example, “generating a disk image” as recited in Claim 23. Thus, Applicant respectfully submits that Claim 22 is allowable. Further, Applicant submits that each of newly added Claims 23 and 24, which depend from Claim 22, are also allowable.

II. New Claims 25-40

By this paper, Applicant has added Claims 25-40. Applicant submits that each of these new claims is fully supported by the specification, and that no new matter is thereby added.

III. Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 3/3/04

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